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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,429	10/14/2003	W. Todd Daniell	190250-1240	7282
38823 7590 04/08/2008 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/ AT&T Delaware Intellectual Property, Inc. 600 GALLERIA PARKWAY, S.E. SUITE 1500 ATLANTA, GA 30339-5994				
EXAMINER				
LAI, MICHAEL C				
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2157				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/686,429

**Applicant(s)**

DANIELL, W. TODD

**Examiner**

MICHAEL C. LAI

**Art Unit**

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

This office action is responsive to amendment filed on 1/8/2008.

#### ***Response to Amendment***

The examiner has acknowledged the amended claims 1 and 10. The 112 rejection to claim 9 has been withdrawn.

#### ***Response to Arguments***

Applicant's arguments filed 1/8/2008 have been fully considered but they are not persuasive.

Applicant's argument, see pages 5-6, Section I, Item A, with respect to a group email message is stored in a common database such that users of the group have access to the group email message via the database, is not persuasive. The reference to Hickey is directed to "provide a group electronic mailbox that is simultaneously accessible to multiple members or users of the group electronic mailbox" (see paragraph 0010). Hickey discloses a database for storing group email messages (see Figure 3 database on Storage unit 30 and paragraph 0021 "retrieves from the database a stored first electronic communication corresponding to the ordered pair"). Hickey further discloses a SQL database is used to store e-communications 47xy in storage 39 (see paragraph 0057).

In view of the foregoing, it is evident that the reference to Hickey clearly provides for the claimed limitation of "the group email message is stored in a common database such that the users in the predefined group of users have access to the group email message via the database."

Applicant's argument, see pages 6-7, Section I, Item B, with respect to a group email message is stored in a common database such that users of the group have access to the group email message via the database, is not persuasive. See above discussion.

Applicant's argument, see page 7, Section I, Item C, with respect to claims 2-7, 9, and 11-12, is not persuasive. These claims depend on either claim 1 or claim 10. Claim 1 and 10 are not allowable as discussed above.

Applicant's argument, see page 7, Section II, with respect to claim 8, is not persuasive. Claim 8 depends on either claim 1. Claim 1 is not allowable as discussed above.

Thus, in view of such, the rejection is sustained as follows:

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hickey et al. (US 2002/0087646 A1, hereinafter Hickey).

Regarding claim 1, Hickey teaches a communication system comprising:

a client-side group email folder accessible by each user in a predefined group of users (FIG. 3 and para. 0037); and

a group email message in the client-side group email folder, the group email message having indicators, each indicator corresponding to a user in the predefined group of users, each indicator being configured to indicate whether the corresponding user has acted upon the group email message, wherein the group email message is stored in a common database such that users of the group have access to the group email message via the database (FIG. 3 and para. 0010, 0021, 0043, 0057).

Regarding claim 2, Hickey teaches the system of claim 1, wherein each indicator comprises a first setting, the first setting indicating that the group email message has not been acted upon by the corresponding user (para. 0079, New).

Regarding claim 3, Hickey teaches the system of claim 2, wherein each indicator further comprises a second setting, the second setting indicating that the group email message has been acted upon by the corresponding user (para. 0043, acted upon information.).

Regarding claim 4, Hickey teaches the system of claim 1, wherein each indicator is further indicative of whether the corresponding user has selected the group email message (para. 0063, first column 143A).

Regarding claim 5, Hickey teaches the system of claim 1, wherein each indicator is further indicative of whether the corresponding user has opened the group email message (para. 0079, Read, Answered, Moved, etc.).

Regarding claim 6, Hickey teaches the system of claim 1, further comprising a second indicator indicative of whether the corresponding user has deleted the group email message (para. 0078, lines 12-20 and para. 0079, lines 1-3).

Regarding claim 7, Hickey teaches the system of claim 1, further comprising means for indicating whether a user has deleted the group email message (para. 0078, lines 12-20 and para. 0079, lines 1-3).

Regarding claim 9, Hickey teaches the system of claim 1, wherein each user represents a unique individual (para. 0051, lines 6-9).

Regarding claim 10, Hickey teaches a communication method comprising:

providing indicators in a group email message, the group email message being located in an inbox, each indicator corresponding to one of the users in a predefined group of users, each indicator having a setting, each indicator configured to indicate whether the corresponding user has acted upon the group email message (para. 0060, step 138 and para. 0061, step 140); and

changing the setting of one indicator in response to the email message being acted upon by its corresponding user (para. 0064), wherein the group email message is stored in a common database such that users of the group have access to the group email message via the database (FIG. 3 and para. 0010, 0021, 0043, 0057).

Regarding claim 11, Hickey teaches the method of claim 10, wherein providing indicators comprises providing read indicators, each read indicator corresponding to

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one user in a predefined group of users, each read indicator being configured to indicate whether its corresponding user has read the email message (para. 0079, Read).

Regarding claim 12, Hickey teaches the method of claim 10, wherein providing indicators comprises providing delete indicators, each delete indicator corresponding to one user in a predefined group of users, each delete indicator being configured to indicate whether its corresponding user has deleted the email message. each delete indicator being configured to indicate whether its corresponding user has deleted the email message (para. 0078, lines 12-20 and para. 0079, lines 1-3).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey, in view of Stark et al. (US 2003/0233420 A1, hereinafter Stark).

Regarding claim 8, Hickey teaches the system of claim 1, but fails to disclose wherein the indicator is an extensible markup language (XML) tag corresponding to a user in the predefined group. However, Stark shows embedded XML tags that describe certain attributes of messages [Page 3, Para. 0035]. It would therefore be obvious to one of ordinary skill in the art at the time of the invention to incorporate

the teaching of Stark into Hickey's system to use XML tag for the indicator corresponding to a user in the predefined group. The motivation would be taking the advantage of the widely accepted language of e-commerce (XML).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part



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of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Lai whose telephone number is (571) 270-3236. The examiner can normally be reached on M-F 8:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai  
20MAR2008

/Yves Dalencourt/

Primary Examiner, Art Unit 2157